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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,807	04/09/2004	M. Bret Schneider	10220-712.200	9053

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EXAMINER

GILBERT, SAMUEL G

ART UNIT	PAPER NUMBER
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3735

MAIL DATE	DELIVERY MODE
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08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,807	Applicant(s) SCHNEIDER ET AL.	
	Examiner Samuel G. Gilbert	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-13, 15-17, 19-21, 27, and 28 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 14 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/15/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-7, 9-12, 15-17, 19-21, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Fox et al (2003/0050527, hereinafter Fox).

Claim 1 - moving a coil and applying current to the coil at a plurality of locations is set forth in paragraph [0086] last sentence. The treatment zone set forth is a single target. While the treatment zone is larger than a point as set forth, it is still considered a single target. Fox sets forth both movement to treat a single target/zone or movement to treat a plurality of targets/sites in a single session.

Claim 2 - the examiner is taking adjusting the “orientation” as “adjusting the position” as claimed. Applicant’s attention is invited to paragraph [0085].

Claim 5 - current is not applied when a magnetic field would be directed to areas to be avoided, paragraph [0122].

Claim 6 - duration is set, paragraph [0122].

Claim 7 - the pulse rate includes inter-pulse interval and is location dependent, paragraph [0122]

Claim 9 - the selecting the speed of movement is inherently required when moving through a treatment zone or between different treatment sites. Applicant's attention is invited to paragraph [0098].

Claim 10 - one or more coils may be used, applicant's attention is invited to the abstract.

Claim 11 - the coil is a TMS coil.

Claim 12 - moving a coil and applying current to the coil at a plurality of locations is set forth in paragraph [0086] last sentence. The examiner is taking adjusting the "orientation" as "adjusting the position" as claimed. Applicant's attention is invited to paragraph [0085].

Claim 15 - current is not applied when a magnetic field would be directed to areas to be avoided, paragraph [0122].

Claim 16 - duration is set, paragraph [0122].

Claim 17 - the pulse rate includes inter-pulse interval and is location dependent, paragraph [0122]

Claim 19 - the selecting the speed of movement is inherently required when moving through a treatment zone or between different treatment sites. Applicant's attention is invited to paragraph [0098].

Claim 20 - one or more coils may be used, applicant's attention is invited to the abstract.

Claim 21 - the coil is a TMS coil.

Claims 27 and 28 - current is applied throughout movement through the treatment zone. The magnetic field is higher in the treatment zone than in the areas to be avoided, set forth in paragraph 122. The treatment zone is considered to be a deep target brain zone.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al (2003/0050527, hereinafter Fox) in view of Muntermann (6,461,289).

Fox teaches a method as claimed but does not teach adjusting the current to produce a constant magnetic field at the target. Muntermann teaches a method of magnetic therapy including applying a constant magnetic field and an alternating magnetic field to the target location. It would have been obvious to one of ordinary skill in the medical arts at the time the invention was made to include additionally providing a constant magnetic field through separate coils, at the target of Fox to gain the advantage of combined constant magnetic field and varying magnetic field therapy as taught by Muntermann.

Allowable Subject Matter

Claims 4, 8, 14, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 4/8/2008 have been fully considered but they are not persuasive. Regarding Fox, the applicant argues that Fox describes using a robotic control system only to treat multiple targets (points), rather than a single target. There is no teaching, or even suggestion, in Fox to direct magnetic field energy from multiple points to a single target so that the magnetic field energy over time at that target adds up and is higher than the surrounding region.

The Examiner disagrees, paragraphs 86 and 98 set forth moving the robotic arm to treat a treatment zone or precisely timed treatments of multiple sites in a single session. It is the examiner's position that the treatment zone is directed the same target while different treatment sites are not. This argument further sets forth that there is no teaching that the magnetic field energy over time at the target adds up and is higher than the surrounding region.

In response, the claims do not require any fields to add up or that the fields added up are higher than the surrounding region.

The claims require magnetic field energy over time higher at the target than areas around the target. It is the examiners position that the magnetic field in the

treatment zone is higher than in areas to be avoided as set forth in paragraph 122. These areas are “around” the target as set forth in the claims.

Regarding the rejection over Fox and Muntermann, the applicant relies on the arguments as addressed above.

The rejections under 35 USC 112 first and second paragraphs have been withdrawn.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel G. Gilbert/
Primary Examiner, Art Unit 3735